

Applicants: Chong-Jin Oon et al.
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91 105. (New) The method of claim 96, wherein the sample is a serum sample.

REMARKS

Claims 19-36 and 38-68 are pending in the subject application. Applicants have hereinabove canceled claims 19-36 and 38-68 without prejudice, and added new claims 69-105. New claim 69 corresponds to claim 19. New claim 70 corresponds to claim 26. New claims 71 to 74 correspond to claims 22 to 25 respectively. New claim 75 corresponds to claim 27. New claim 76 corresponds to claim 35. New claims 77 to 80 correspond to claims 31 to 34 respectively. New claim 80 corresponds to claim 34. New claim 81 corresponds to claim 36. New claim 82 corresponds to claim 38. New claim 83 corresponds to claim 40. New claim 84 corresponds to claim 42. New claims 85 to 93 correspond to claims 44 to 52. New claims 94 to 103 correspond to claims 55 to 64. New claims 104 and 105 correspond to claims 67 and 68 respectively. New claims 70 to 74, 76 to 81, 83, 86 to 95, and 97 to 105 are identical to the claims to which they correspond, but for the claim renumbering.

Support for new claim 69 can be found in the specification as originally filed at, *inter alia*, page 9, lines 17-25. Support for new claim 70 can be found in the specification as originally filed at, *inter alia*, page 9, lines 22-35. Support for new claim 71 can be found in the specification as originally filed at, *inter alia*, page 9, lines 22-23. Support for new claim 72 can be found in the specification as originally filed at, *inter alia*, page 9, lines 24-29. Support for new claim 73 can be found in the specification as originally filed at, *inter alia*, page 14, line 26-29. Support for new claim 74 can be found in the specification as originally filed at, *inter alia*, page 13, line 32. Support for

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new claim 75 can be found in the specification as originally filed at, *inter alia*, page 9, lines 22-35; and page 14, line 26-29. Support for new claim 76 can be found in the specification as originally filed at, *inter alia*, page 9, lines 25-29. Support for new claim 77 can be found in the specification as originally filed at, *inter alia*, page 9, lines 22-23. Support for new claim 78 can be found in the specification as originally filed at, *inter alia*, page 9, lines 24-29. Support for new claim 79 can be found in the specification as originally filed at, *inter alia*, page 14, lines 26-29. Support for new claim 80 can be found in the specification as originally filed at, *inter alia*, page 13, line 32. Support for new claim 81 can be found in the specification as originally filed at, *inter alia*, page 10, lines 10-17. Support for new claim 82 can be found in the specification as originally filed at, *inter alia*, page 10, lines 18-24. Support for new claim 83 can be found in the specification as originally filed at, *inter alia*, page 10, lines 21-22. Support for new claim 84 can be found in the specification as originally filed at, *inter alia*, page 10, lines 10-24. Support for new claims 85-95 can be found in the specification as originally filed at, *inter alia*, page 14, line 31 to page 18, line 21; page 9, lines 14-35; page 14, lines 26-29; and page 11, line 15. Support for new claim 96 can be found in the specification as originally filed at, *inter alia*, page 9, line 14; and page 10, line 4, and page 8, lines 13-21. Support for new claim 97 can be found in the specification as originally filed at, *inter alia*, page 9, line 19. Support for new claim 98 can be found in the specification as originally filed at, *inter alia*, page 9, line 27. Support for new claim 99 can be found in the specification as originally filed at, *inter alia*, page 9, line 23. Support for new claim 100 can be found in the specification as originally filed at, *inter alia*, page 9, line 27. Support for new claim 101 can be found in the specification as originally filed at, *inter alia*, page 10, lines 4-5. Support for new claim 102 can be found in the

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specification as originally filed at, *inter alia*, page 14, lines 26-29. Support for new claim 103 can be found in the specification as originally filed at, *inter alia*, page 9, lines 22-27. Support for new claim 104 can be found in the specification as originally filed at, *inter alia*, page 10, lines 21-22. Support for new claim 105 can be found in the specification as originally filed at, *inter alia*, page 10, lines 2-3.

Applicants contend that the amendments to the claims do not involve any issue of new matter. Accordingly, applicants respectfully request entry of this Amendment such that claims 69-105 will be pending and under examination.

Formalities

In the August 6, 2002 Office Action the Examiner stated that the request on July 22, 2002, for a Continued Prosecution Application (CPA) under 37 C.F.R. §1.53(d) based on parent application No. 09/362,394 is acceptable and a CPA has been established. The Examiner stated that claims 20, 21, 26, 29, 30, 35, 36, 39, 41, 43, 44, 46-50, 52-54, 57-62, and 64-66 were amended, and claim 37 was canceled. The Examiner also stated that claims 19-36 and 38-68 are pending and under examination. The Examiner stated that the amendments to the specification and the claims to add SEQ identifiers are noted and are sufficient to comply with the sequence rules.

The Examiner stated that applicants' amendments to the claims have overcome the rejections of claims 46-50, 52, 58-62, and 64 as previously made under 35 U.S.C. §112, second paragraph; the Examiner also stated that as no amendments or remarks were

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directed to the interpretation of "has" in claims 43, 53, 54, 65 and 66, the recitation of "has" continues to be interpreted as open language.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 32 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner stated that claim 32 is indefinite because it recites "primary amine" without clear antecedent since claim 32 depends from claim 27 which recites "primary amino", and that it is believed that "primary amine" is what was intended.

In response, applicants have hereinabove canceled claim 27.

Rejection Under 35 U.S.C. §103(a)

The Examiner rejected claims 19-36 and 38-68 under 35 U.S.C. §103(a) as being allegedly unpatentable over WO 97/40193 to Stuyver et al., of record, in view of Guo et al. (Nucleic Acids Research 22(24):5456-5465, 1994, and of U.S. Patent No. 6,100,030 to McCasky Feazel et al.

In response, applicants respectfully traverse the Examiner's rejection.

Applicants maintain that the Examiner has failed to set forth a prima facie case of obviousness because the cited references, in combination, fail to teach or suggest all elements of the rejected claims. Specifically, applicants note that the oligonucleotide sequences recited in the instant claims are not

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taught by Stuyver et al., Guo et al. or McCasky Feazel et al. Furthermore, applicants disagree with the Examiner's assertion that it would have been obvious for one of skill in the art to have selected other probes including "relevant portions" of HbsAg. Applicants assert that what is relevant, and which particular probe sequences have been selected, has been determined by the Examiner using impermissible hindsight based on applicants' discovery set forth in the application.

Moreover, there is no teaching or suggestion in the cited references that particular oligonucleotide sequences (namely those recited in the claims) would be obvious to combine with specific fluorescent labels and C-7 amines.

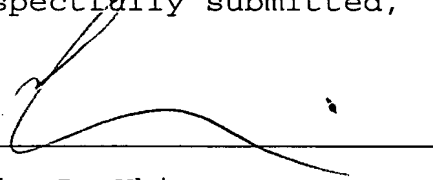
Accordingly, applicants maintain that the Examiner has not set forth a case of prima facie obviousness over the cited references, and thus, new claims 69-105, directed to the same subject matter as previous claims 19-36 and 38-68, satisfy the requirements of 35 U.S.C. §103.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

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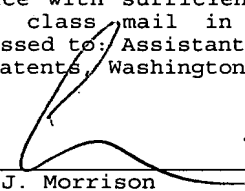
No fee, other than the \$110.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



Alan J. Morrison
Reg. No. 37,399

12/6/02
Date